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REMARKS

This is a full and timely response to the final Official Action mailed February 7, 2008 (the "Action" or "Office Action"). Reconsideration of the application in light of the the following remarks is respectfully requested.

Claim Status:

No amendments to the application are proposed by the present paper. Thus, claims 1-25 are currently pending for further action.

Objection to Drawings:

Both the present final Office Action and the previous non-final Office Action have objected to the drawings as being "without labels." (Action of 8/22/07, p. 2). Applicant has explained that, under 37 C.F.R. § 1.83, no additional labeling is needed or required for the type of drawings the Applicant has presented.

In response, the final Office Action charges that "Applicant misconstrues the term 'label representation.' The Examiner requires application to change the numerical label; i.e. Element 170 of Fig. 1A should be relabeled as "light source". This applies to all numerical elements of all drawings." (Action, p. 11). This, however, is contrary to the rules and the established practice with respect to U.S. patent applications.

37 C.F.R. § 1.84(p)(1) governs reference characters and states explicitly that "numerals are preferred." 37 C.F.R. § 1.84(t) and (u)(2) also state that numbers are to be used for the reference characters in drawings.

The Examiner has provided no authority in the rules for contravening decades of established practice and requiring descriptive labels in place of "all numerical elements of all

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drawings.” (Action, p. 11). Until the Examiner has done so, Applicant prefers to follow the standard practice in U.S. patent applications of using reference numbers for the elements in figures that are not block diagrams in accordance with 37 C.F.R. § 1.84(p)(1).

Moreover, Applicant has not attempted to construe the term “label representation.” Rather, Applicant has merely quoted 37 C.F.R. § 1.83, which expressly defines a labeled representation as, for example, “a labeled rectangular box” as in a block diagram. (37 C.F.R. § 1.83). As noted previously, Applicant’s application does not include any block diagrams.

For at least these reasons, the objection to the drawings is thought to be improper. Therefore, Applicant respectfully requests that the objection to the drawings be reconsidered and withdrawn.

Prior Art:

Claims 1-6, 9-13, 20 and 21 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent App. Pub. No. 2002/0109867 to Seseek et al. (“Seseek”). Although not included in the listing, it appears that the Office Action also intended claim 14 to be included in the rejection under § 102(b) based on Seseek. For at least the following reasons, this rejection should be reconsidered and withdrawn.

The Office Action does not seem to appreciate that the present application and Seseek approach the same problem in fundamentally different ways. The problem is to select only a part of a printed page to be scanned by a scanner. This may be desired because there is some material or extraneous marks on the printed page that the user does not want included in the scanned document. (Applicant’s specification, paragraph 0003). Additionally, if scanning a page from a book or other bound volume, “the spine of the scanned bound set of documents will often show on the reproduced image as a shadow or umbra” which is undesirable.

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(Applicant's specification, paragraph 0003). Thus, the goal is to reduce the area scanned to only that portion of the printed page desired so that other markings or the shade from the spine of a book, for example, not being reproduced by the scanner.

Sesek takes an electronic approach to this issue in which the scanner is electronically instructed to scan or reproduce material from only a portion of the scanning bed. The scanning hardware is not operated at other portions of the scanning bed. So, only the desired window on the document being scanned is reproduced. Sesek uses pointers or bars on the scanner that slide along edges of the scanning bed to define a desired scan window or limited scan area. The scanner electronically monitors the position of the pointers or bars and then scans only that area defined within the pointers.

Accordingly, Sesek teaches the following. "An apparatus and system for scanning a bounded scan area within a scanable surface of a scanning device are provided. The present invention includes a plurality of members constructed and arranged to define a scan area on a scanable surface of the scanner, a link for communicating with the control interface of the scanner, and a switch for generating a signal to the control interface to initiate and complete a scan of the bounded scan area defined by the plurality of members." (Sesek, abstract).

In contrast to the electronic approach taken by Sesek, the current application takes a mechanical approach for controlling a desired portion of a printed document that is to be scanned. In the present application, shades can be pulled from each edge of the scanner bed to cover everything from that edge of the scanner bed to the lead edge of the shade. Consequently, a desired portion of that edge of the scanning bed is obscured so that only a limited scanning window remains. The underside of the shades is light or white, like blank paper. The scanner then scans the entire bed, but collects no image where the document is obscured by the shades.

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These fundamental differences between the teachings of Sesek and the present application are clearly recited in Applicant's claims. For example, claim 1 recites:

An image reproduction apparatus comprising:  
a scanning device;  
a transparent scanning bed optically coupled to said scanning device; and  
an adjustable shade associated with said scanning bed;  
*wherein said adjustable shade is configured to be selectively extended from a position adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade, an underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.*  
(Emphasis added).

In contrast, Sesek does not appear to teach the claimed adjustable shade that is selectively extended to cover a portion of scanning bed *from the edge of the bed to a leading edge of the shade*. Rather, Sesek teaches a scanner with "a plurality of members constructed and arranged to define a scan area on a scanable surface of the scanner, a link for communicating with the control interface of the scanner, and a switch for generating a signal to the control interface to initiate and complete a scan of the bounded scan area defined by the plurality of members." (Sesek, abstract). Accordingly, Sesek teaches pointers (Fig. 3) or bars (Fig. 1) that are only used to define an area to be scanned, not to cover or shade a portion of the scanning bed *from the bed's edge to a leading edge of the shade*, as claimed.

To further illustrate this point, Figs. 1 and 3 of Sesek are reproduced below. As can be clearly seen from these figures, the bars (Fig. 1) or the pointers (Fig. 3) are used merely to indicate electronically a portion (14') of the scanning bed (11) that is to be scanned. The bars and pointers of Sesek are not capable of masking or obscuring portions of the scanning bed where no image is to be captured.

Specifically, neither the pointers nor bars of Sesek can be reasonably construed as an adjustable shade "wherein said adjustable shade is configured to be selectively extended from

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a position adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade." (Emphasis added).

As can be clearly seen in either Fig. 1 or Fig. 3, after the pointers or bars are deployed, there are portions of the scanning bed between the edges of the bed and the bars (15) for example, that are *not covered*. This is clearly contrary to the highlighted recitations of claim 1.

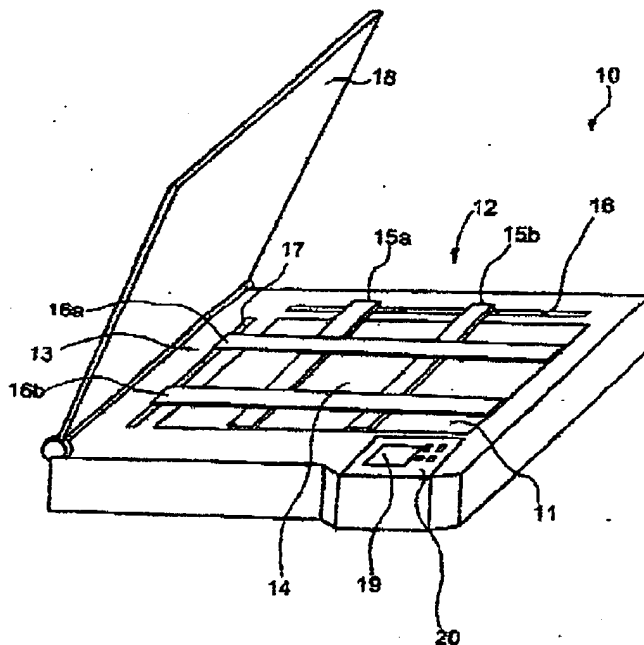


FIG.1

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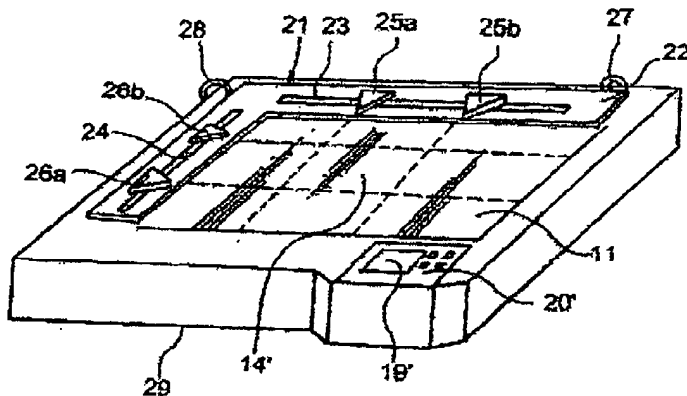


FIG. 3

Additionally, Seseek does not appear to teach or suggest “an underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.” Seseek does not teach or suggest the claimed apparatus where an extended shade is part of the area scanned, but is colored so as not to produce any markings in the resulting image. Rather, Seseek teaches an “apparatus, system and method [that] scans only a user defined enclosed scan area, instead of the scanning device scanning the entire scanable surface without additional user manipulation.” (Seseek, paragraph 0037) (emphasis added).

The Office Action mentions several times the recitation of claim 1 that “an underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.” However, the Office Action does not ever clearly or with any specificity indicate how or where this subject matter is taught or suggested by Seseek. In contrast, because Seseek is indicating electronically, rather than mechanically,

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what portion of the document to scan, Seseek would not teach or suggest that “an underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.”

Consequently, Seseek fails to teach or suggest the subject matter of amended claim 1. “A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, the rejection based on Seseek of claim 1 and its dependent claims should be reconsidered and withdrawn.

Claim 11 now recites:

A method of adjusting the target area of an image reproduction apparatus comprising:  
*selectively covering an edge of scanning bed by drawing a shade over said edge of said scanning bed;*  
placing said object on said drawn shade; and  
scanning said object  
*wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed.*  
(Emphasis added).

In contrast, as demonstrated above, Seseek does not appear to teach or suggest a method of adjusting a target area of an image reproduction apparatus by “selectively covering an edge of scanning bed by drawing a shade over said edge of said scanning bed.” Seseek teaches markers for defining an area to be scanned, not for selectively covering an edge of the scanning bed in the manner claimed.

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Moreover, as discussed above, Sesek does not appear to teach or suggest "wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed." The recent Office Action fails to indicate how or where Sesek specifically teaches this subject matter.

Consequently, Sesek fails to teach or suggest the subject matter of claim 11. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, the rejection based on Sesek of claim 11 and its dependent claims should be reconsidered and withdrawn.

Claim 14 recites:

An optical scanner with an adjustable shade comprising:  
a shade reel disposed at an edge of a scanning bed of said optical scanner; and  
a shade coupled to said shade reel;  
*wherein an underside of said shade that is presented to said scanning bed is colored such that said optical scanner does not output any image markings when scanning said underside of said shade thereby effectively reducing a scan target area of said optical scanner.*

(Emphasis added).

As demonstrated above, Sesek fails to teach or suggest an optical scanner with a shade "wherein an underside of said shade that is presented to said scanning bed is colored such that said optical scanner does not output any image markings when scanning said underside of said shade thereby effectively reducing a scan target area of said optical scanner."

Additionally, Sesek clearly fails to teach or suggest the claimed "a shade reel disposed at an edge of a scanning bed of said optical scanner." This fact is expressly conceded in the



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Office Action, which states that "Sesek does not disclose a shade reel." (Action of 8/22/07, p. 8).

Consequently, Sesek fails to teach or suggest the subject matter of claim 14. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, the rejection based on Sesek of claim 14 and its dependent claims should be reconsidered and withdrawn.

In a previous Office Action, claim 14 was rejected under 35 U.S.C. § 103(a) in view of Sesek and U.S. Patent No. 6,695,381 to Schlecht ("Schlecht"). It is unclear why the Office Action has now included the rejection of claim 14 under the rejection under § 102 as anticipated by Sesek alone. Perhaps this is because Applicant previously pointed out that the proposed combination of Sesek and Schlecht would be inappropriate for the following reasons.

"A patent [or patent application claim] composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." According to the Supreme Court, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (*KSR International Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (2007)). In the present case, there is

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absolutely no reason in the prior art, to have combined the teachings of Seseek and Schlecht as proposed in the Office Action.

As explained above, Seseek does not teach means for covering or shading portions of the scanning bed. Rather, Seseek calls for pointers or bars that can be used to outline a desired scanning area. Consequently, there could be no use whatsoever in the Seseek device for a shade reel as recited in claim 14.

Moreover, Schlecht, as noted above, is directed to providing a windup window shade, for example, in an automobile. (Schlecht, abstract and Fig. 1). Thus, Schlecht does not teach or suggest any application for a shade reel on an optical scanner.

Thus, the combination of Seseek and Schlecht proposed in the Office Action is based entirely on impermissible hindsight. A large number of devices may exist in the prior art where, if the prior art is disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the Applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Applicant's claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure.

The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568. Respectfully, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious"; *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1141, 227 USPQ 543, 550 (Fed. Cir.

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1985); *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)

“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner’s conclusory statements in support of the alleged combination fail to establish a prima facie case for obviousness. *See, KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_\_\_ (2007) (obviousness determination requires looking at “whether there was an apparent reason to combine the known elements in the fashion claimed...,” citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” *KSR* at 14).

Consequently, claim 14 recites subject matter that is clearly beyond the scope and content of the cited prior art. Therefore, Sesek and Schlecht would not support a rejection of claim 14 or its dependent claims under 35 U.S.C. § 103(a) and *Graham*.

Claim 20 now recites:

A scanning device for eliminating unwanted areas of a scanned image, said scanning device comprising:  
means for scanning; and  
means for selectively covering edges of a scanning bed such that said means for scanning outputs no image markings when scanning said covered portions of said scanning bed;  
wherein said means for covering edges of said scanning bed are configured to selectively reduce an effective scanning area of said means for scanning.  
(Emphasis added).

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In contrast, as demonstrated above, Seseek does not appear to teach or suggest a scanning device like that claimed with "means for selectively covering edges of a scanning bed such that said means for scanning outputs no image markings when scanning said covered portions of said scanning bed." Rather, Seseek teaches means for defining a smaller area within a scanning bed, where only the smaller defined area is scanned.

Moreover, as clearly seen in Fig. 1 of Seseek, reproduced above, when the bars (15) are deployed, the edges of the scanning bed are *not* covered. Rather, the edges of the scanning bed are almost entirely visible. Thus, Seseek cannot be reasonably construed as teaching the claimed "means for selectively *covering edges of a scanning bed* such that said means for scanning outputs no image markings when scanning said covered portions of said scanning bed."

Consequently, Seseek fails to teach or suggest the subject matter of amended claim 20. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Seseek of claim 20 and its dependent claims should be reconsidered and withdrawn.

Claims 7, 8, 15-19, 22 and 23 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Seseek and U.S. Patent No. 6,695,381 to Schlecht ("Schlecht"). This rejection should be reconsidered for at least the same reasons given above in favor of the independent claims.

Moreover, for the reasons explained above with respect to claim 14, the combination of Seseek and Schlecht is inappropriate and motivated entirely by hindsight based on

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Applicant's own disclosure. For at least this additional reason, this rejection under § 103 should *not* be sustained.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.


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If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: March 27, 2008

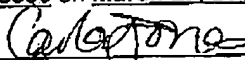
  
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Carla Jones